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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/875,158	06/07/2001	Shinya Watanabe	Q64848	7273

7590 09/26/2003
SUGHRUE, MION, ZINN,
MACPEAK & SEAS, PLLC
2100 Pennsylvania Avenue, NW
Washington, DC 20037-3213

EXAMINER

BADIO, BARBARA P

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 09/26/2003

25

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/875,158

Applicant(s)

WATANABE ET AL.

Examiner

Barbara P. Badio, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4,5 and 15 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1,4,5 and 15 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- ☐ Interview Summary (PTO-413) Paper No(s). ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

First Office Action on the Merits of a RCE

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 28, 2003 has been entered.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 103

3. The rejection of claims 2, 3 and 6-14 under 35 USC 103(a) over Mookherjee et al. ('098) and Kampf (DE 3003894) and Boshagen et al. ('242) in combination is made moot by the cancellation of the instant claims.

4. The rejection of claims 1, 4, 5 and 15 under 35 USC 103(a) over Mookherjee et al. ('098) and Kampf (DE 3003894) and Boshagen et al. ('242) in combination is maintained.

Applicant argues that there would be no reason for one of ordinary skill in the art to modify Mookherjee in view of Boshagen or Mookherjee/Kampf in view of Boshagen and, even if the combination is made, there would be no reasonable expectation of success. Applicant also argues that while the reaction conditions between the Declaration and Mookherjee are not completely identical, they are regarded as about the same in view of the bases involved, the reaction temperature, the reaction time and the solvents used. Applicant's argument was considered but not persuasive for the following reasons.

As stated in the previous Office Action, Mookherjee teaches the same isomerization process as recited by the claimed invention. The difference is in the recitation of the solvent utilized. Kampf and Boshagen were utilized for their teachings of the recited solvents in similar process, i.e., isomerization process, utilizing similar catalysts as taught by Mookherjee and recited by the instant claims. Thus, the utilization of the solvents taught by Kampf and Boshagen in the isomerization of the 1 α -acetyl-2 α ,6,6-trimethyl-3-cyclohexane as taught by Mookherjee would be prima facie obvious because of the knowledge provided by Kampf and Boshagen as stated above. It should also be noted that Boshagen teaches an equivalent between lower alcohols, as exemplified by Mookherjee, and other solvents such as dimethylsulfoxide, as recited by the instant invention, in isomerization reactions. Thus, the skilled artisan would have the reasonable expectation that the process taught by Mookherjee would run to completion in the presence of other solvents such as DMSO. The lack of recitation of the identical end products as recited by instant claims is irrelevant because the skilled

artisan would expect similar starting material to result in similar end products and the court has held that the recitation of the products produced does not lend patentability to an old process.

If the novelty of the presently claimed process is in the utilization of particular solvent(s), applicant needs to provide a convincing side-by-side comparison of the processes under identical reaction conditions utilizing different but identical amounts/concentrations of the solvent exemplified by the Mookherjee and that recited by the instant claims. The showing should also be commensurate in scope with the claimed invention. One cannot argue unexpected and/or unobvious results without a true side-by-side comparison and, thus, the Declaration filed June 12, 2002 is not persuasive.

For these reasons and those given in previous Office Actions, the rejection of claims 1, 4, 5 and 15 under 35 USC 103(a) over Mookherjee et al. ('098) and Kampf (DE 3003894) and Boshagen et al. ('242) in combination is maintained.

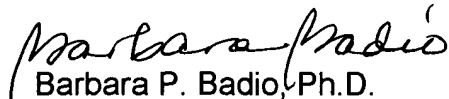
Telephone Inquiry

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara P. Badio, Ph.D. whose telephone number is 703-308-4595. The examiner can normally be reached on M-F from 7:30am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page can be reached on 703-308- 2927. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.


Barbara P. Badio, Ph.D.
Primary Examiner
Art Unit 1616

BB
September 25, 2003